

pending in this application.

THE CLAIM AMENDMENTS

Applicant submits that no new objectionable matter within the meaning of 35 U.S.C. §132 has been added by the amendments to claims 2 and 10. The amendments to the claims are fully supported by the specification as filed and by the original claims.

THE WRITTEN DESCRIPTION REJECTION

Claim 37 stands rejected under 35 U.S.C. §112, first paragraph, allegedly as for lacking of a written description in the specification. This rejection is traversed.

Applicant has canceled claim 37 without prejudice or disclaimer to the subject matter contained therein. This rejection is therefore moot.

THE OBVIOUSNESS REJECTION

Claims 2, 5, and 10-16 stand rejected under 35 U.S.C. §103(a), allegedly as being obvious over Reeber in view of Chu and vice versa, and the Marto and Lepere article, and over the Hesketh dissertation. This rejection is emphatically traversed.

The examiner is in error when he states that the issues raised in this application are not the same as those issues put forth before the Board in the parent case. See, page 2 of the Office Action. In particular, the examiner errs when stating that most of the claims in this application lack the feature that “reversal of trend less than 2 degrees C and without a temperature overshoot on the initial ascent.” This feature was the basis for the Board overturning the rejection of the claims based on the cited prior art in the parent application. Clearly, the examiner did withdraw the rejection of claim 8, since claim 8 did include the feature relied upon by the

Board in overturning the rejection of the parent claims over the prior art. Present independent claims 2 and 10 include this feature as well, and should be allowed. The remaining claims depend directly or indirectly from claims 2 or 10, and thus contain all of the features found in the independent claims. Thus, the issues that may be raised by the currently rejected claims are identical or substantially identical to the issues raised before the Board in the parent case. As such, the doctrines of res judicata and collateral estoppel prevent the examiner from maintaining the rejections of the claims over the same art cited in the parent application.

The examiner restates his previously failed argument that the Board made a “mistake of fact” and that this “mistake” justifies his continued rejection of the claims. In his allegation the examiner states that:

It is submitted that the Board may have erred in a factual manner in assuming the values found in Table 1 (specification, page 20) with respect to Marto and Lepere prior art correctly portrayed the performance of the “Aging C” and “Aging D” examples. See paragraph bridging pages 8 and 9 of the Board decision. The Board essentially ignored the fact that the Examiner was challenging the values in Table 1 of applicants’s specification pertaining to Marto and Lepere as inaccurate with respect to the “Aging C” or “Aging D” surfaces shown in Figure 11 of Marto and Lepere. The reasons that the Examiner believes applicant’s values are deemed inaccurate are set forth in the Examiner’s Answer (in particularly detailed discussion on pages 9-15) incorporated here by reference. It is believed that the Board has made an error of fact their analysis, a problem with the Board decision that the Examiner found when taking up this application for examination. (Office Action, Pages 7-8, emphasis in original).

The Applicants beg to disagree with this assertion. The examiner is attempting to reject claims based on the precise arguments that were fully considered and rejected by the Board, and for which the examiner failed to request rehearing or to reopen prosecution as previously detailed. In view of Board’s final decision, the examiner is barred by the doctrines of res judicata and collateral estoppel, and may not, under the guise of recent discovery, simply ignore the decision by the Board of Appeals that is adverse to his own position.

It is clear that the Board considered and rejected the examiner’s argument regarding the meaning of facts in the record, especially those facts that the examiner is alleging the Board made a mistake in when interpreting the prior art. The examiner’s argument with respect to the discussion of the Marto and Lepere article is contained, among other places, on page 11-12 of the examiner’s Answer of the appeal. In particular,

the examiner asserts at page 11 that:

While applicant's Figures 14-16 purport to show testing against Marto and Lepere, the comparison is illusory because applicant's Figures 14-16 only plot the data for the Thermoexcel-E coating which were treated using "Aging A", not the far more pertinent "Aging C" or "Aging D" shown in Figure 11 of Marto and Lepere. It is interesting to note that applicant fails to even specify what particular test data from Marto and Lepere was lifted from that reference and re-plotted onto applicant's Figures 14-16 (see page 19 of the specification). The examiner believes it must have been Run 17 (Surface Aging A) from Figure 11 which has an enormous hysteresis compared to Run 10 (Surface Aging C) and Run 16 (Surface Aging D).

As can be seen, the examiner explicitly set forth in his Reply the exact same proposition regarding the data included in the present application. Thus, the examiner put the exact same issue before the Board that he is attempting to employ to reject the present claims in the instant Office Action, and was overturned by the Board.

In overruling the rejection of the claims based on the cited art, the Board clearly rejected the examiner's arguments. Moreover, when the Board expressly addressed the Marto and Lepere article in their decision, at pages 8-9, they stated that:

Notwithstanding, the clear relevance of the above reference disclosures [including the Marto and Lepere article] to the method of claim 1, akin to the examiner's understanding of the evidence of obviousness, we perceive a lack of indication or suggestion in the applied prior art for the claimed method feature of the heating of the surface initiating nucleate boiling of the refrigerant with a reversal of trend of less than 2°C and without a temperature overshoot on the initial ascent. Figure 16 graphically reveals what is intended by this claimed limitation during the initial ascent. Appellant makes aware in Table 1 (specification, page 20) that, compared to measured reversal of trend for the present invention, the reversal of trend with Thermoexcel-E of the Marto and Lepere article (1982) is significantly higher. As this table indicates appellant's invention yields reversals of trend less than 2°C, as now claimed. The examiner's concern (answer, page 11) regarding what additional testing, vis-a-vis the teachings in the Marto and Lepere, might reveal can only be fairly viewed as speculation. (Emphasis in original).

The Board affirmed the patentability of the claims while rejecting the examiner's arguments against patentability, including those argument being currently employed against the claims. **Based on the Board decision, the examiner is estopped from rebirthing against the patentability of the present claims the**

arguments that were rejected by the Board in their decision in the parent application.

Claim 37 has been canceled, thus rendering the rejection of the claim moot.

Accordingly, Applicants request reconsideration and withdrawal of the above rejection.

THE DOUBLE PATENTING REJECTION

Claims 2, 5, 8, and 37 stand rejected under the judicially-created doctrine of obviousness-type double patenting, over claims 1-9 of U.S. Patent No. 6,371,199, allegedly because they are not patentably distinct but “merely recite the invention more broadly than the corresponding claims in USP ‘199”. This rejection is traversed.

Claims 8 and 37 have been canceled. Applicants proffer the submission of a suitable Terminal Disclaimer upon indication of allowance of the claims over the cited prior art with regards to claims 2 and 5. Applicants proffer the Terminal Disclaimer only as a means for advancing prosecution, and the eventual filing of the Terminal Disclaimer in no way should be construed as an admission that claims 2 and 5 are obvious over claims 1-9 of the ‘199 patent.

The examiner is thus invited to indicate the allowability of claims 2 and 5 so that a proper Terminal Disclaimer may be filed.

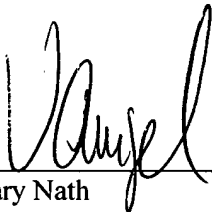
Attorney Docket No.: 24876-A
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Based upon the above remarks, the claimed invention is believed to be novel, patentably distinguishable over the prior art of record and therefore allowable. The examiner is therefore requested to reconsider and withdraw the rejections of remaining claims 2, 5, and 10-16, and allowance all pending claims. Favorable action with an early allowance of the claims pending in this application is earnestly solicited.

Respectfully submitted.
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